

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)

Barrett, Jr.)

Serial No. 09/436,387)

Filed: February 7, 2000)

For: **GUIDED BULLET**)

Attorney Docket No. 4419-001)

B. Gregory
Primary Examiner
Art Unit 3662

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17/Reply
Brief

Dates
8/27/01

August 15, 2001
Raleigh, North Carolina

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Washington, D.C. 20231

Reply to Examiner's Answer

*Noted
7/27*

The Examiner's Answer, filed August 3, 2001 in the present reexamination appeal, has been thoroughly considered. Applicant is at a complete loss to understand the Examiner's objections as to form. The Examiner asserted that Applicant's brief does not contain a statement identifying the related appeals and interferences. The statement that there are no related appeals or interferences is numbered paragraph 2 on page 1 of Applicant's Appeal Brief. Similarly, the Examiner stated that Applicant's brief does not include a statement concerning the grouping of claims. The statement that claims 30-32 are grouped together, and stand or fall together, is numbered paragraph 7 on page 3 of Applicant's Brief.

The Examiner's substantive argument does not stand scrutiny, and is tantamount to a new ground of rejection, in violation of 37 C.F.R. § 1.193(a)(2). The Examiner is attempting to read into claims 30 and 32, based on the adjective "rifle" in the preamble, the substantive limitation of

a rifled barrel imparting an axial spin to a bullet – an asserted limitation that is negated not only in the specification by the repeated description of the rifle as "smooth bore," but also explicitly denied, negated, and refuted by Applicant during prosecution to avoid prior art. At no point during the prosecution of the instant reissue application did the Examiner ever raise any objection whatsoever to the term rifle bullet, or suggest that the term implied inclusion of surrendered subject matter. In fact, the Examiner's last stated ground of rejection was that the claims contained new subject matter, "[T]he fact that claims 30-32 are directed to inventions that were not claimed in the original application amounts to recapture under present USPTO policy." Final Office Action of January 1, 2001, p. 2, ¶ 1. This imposition of a new ground of rejection in the Examiner's Answer is impermissible. See MPEP § 1208.01.

Even if properly imposed, the objection is frivolous. Applicant would readily agree to an Examiner's amendment inserting the modifier "smooth bore" in the preamble to claims 30 and 32 (or alternatively, omitting the phrase "pistol or rifle" altogether), to allow the instant appeal to address the real issues. Applicant would have already so amended the claims if the Examiner had raised the slightest hint of objection to the term. That the bullet of the present invention is to be fired from a smooth bore weapon – one without a rifled barrel – is indisputable. According to the written description of the patent on which the present reissue application is based:

In contrast [to a bullet designed for a rifled barrel], the guided bullet 10 of the present invention is designed to be fired from a non-rifled, smooth bored gun barrel. Imparting a spin to the guided bullet 10 of the present invention would not only be unnecessary, but it would also be detrimental to the performance of the same.

U.S. Patent No. 5,788,178, col. 4, ll. 36-41 (emphasis added).

In addition, claim 1 of the '178 patent recites, "said bullet being fired from a precision, smooth-bored weapon thereby not imparting axial spin to said bullet." Also, claim 11 recites,

"firing said bullet from a precision sniper rifle having a smooth internal bore." These claim limitations may be traced to an amendment filed December 1, 1997 in response to an Examiner's citation of U.S. Patent No. 4,537,371 to Lawhorn, which teaches a spin stabilized, fin-guided projectile. As Applicant clearly indicated in its Appeal Brief of July 17, 2001, spin stabilization of a bullet via a rifled barrel is not, and has never been, an element of the claimed invention. Applicant readily "surrendered" spin stabilization of a bullet during prosecution, by adding the limitation of non-spin to the claims to avoid Lawhorn, because as the written description clearly discloses, spin stabilization is antithetical to Applicant's very invention. Reissue claims 30 and 32 do not capture, much less recapture, spin stabilization of a bullet. Again, Applicant could easily have removed all possible doubt on this point, had the Examiner raised the objection prior to appeal from final rejection.

Furthermore, the usage of the term "rifle" in the preamble of claims 30 and 32 does not support the Examiner's assertion. The complete phrase appearing in both claims is, "a pistol or rifle bullet." In this context, the term "rifle" simply distinguishes a rifle from a pistol, *i.e.*, a shoulder-mounted firearm as opposed to a side arm. In fact, the Examiner's asserted definition would render the entire phrase nonsensical. Every modern pistol has a rifled barrel, imparting an axial spin to its bullet. If "rifle bullet" were to necessarily denote (as the Examiner asserts) a bullet fired from a rifled barrel, the disjunction with the term "pistol" would render that term meaningless, as there are essentially no smooth bore pistols.

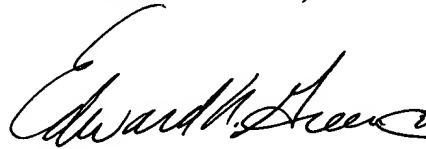
In attempting to import the admittedly surrendered limitation of spin stabilization into the reissue claims via a technical semantic argument relying wholly on inference, the Examiner has ignored the central issue in this appeal – whether claiming in a reissue application elements of an invention disclosed but not claimed (through error without deceptive intent) in the parent

application invokes the recapture doctrine? Specifically, as articulated by Applicant and as the Examiner agreed – Whether “Each and every point argued by Applicants on the record as defining over the prior art applied in the rejections of record in the patent application as well as the points set forth in the Examiner’s Statement of Reasons for Allowance must be contained in any claims to be issued in this reissue application,” is a proper statement of patent law, and if so, whether it is applicable in the present reissue application. The Examiner remains silent on these issues. As Applicant extensively explained in its Appeal Brief, the answer to both questions is no. The reissue claims include no subject matter that was surrendered during prosecution, and hence need not recite those elements under 35 U.S.C. § 251. The recapture doctrine is simply inapposite to the present case.

Respectfully submitted,

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